THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte MICHEL POZZO

_____

Appeal No. 96-3610
Application 08/300,567[1]

_____

ON BRIEF

_____

Before COHEN, ABRAMS and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

[1] Application for patent filed September 6, 1994. According to appellant, the application is a division of Application 08/007,857, filed January 22, 1993, now U.S. Patent 5,348,157, issued September 20, 1994.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 23 and 24 and from the refusal of the examiner to allow claims 25 through 27, as amended (Paper No. 16) subsequent to a final rejection (Paper No. 9). Claims 19 and 22, the only other claims remaining in the application, stand allowed.

Appellant's invention pertains to an inflatable cushion for use in packaging items in a box. An understanding of the invention can be derived from a reading of exemplary claim 23, a copy of which appears in the APPENDIX to appellant's amended brief (Paper No. 23).

As evidence of obviousness, the examiner has applied the documents listed below:

Ericson	3,332,415	Jul. 25, 1967
Giovanni[2] (Italy)	637,711	Sep., 1966

[2] The information specified here with respect to this document is taken from the examiner's "NOTICE OF REFERENCES CITED" form dated June 26, 1995, an attachment to Paper No. 9.

The following rejections are before us for review.

Claims 23 through 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Giovanni in view of Ericson.

Claims 23 through 27 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 24), while the complete statement of appellant’s argument can be found in the amended brief (Paper No. 23).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant’s specification and claims, the applied references, and the respective viewpoints of appellant and the examiner. As a

consequence of our review, we make the determinations which follow.

The obviousness rejection

We must reverse this rejection under 35 U.S.C. § 103.

The examiner applies two documents as evidence in this rejection. We shall focus entirely upon the reference denoted by the name Giovanni. In the rejection (answer, page 4), it is indicated that, as to this reference, "[f]igures were all that were available to the examiner." In the application file, we find a document that is a single sheet with drawing Figures on both sides thereof that appear to portray something referenced by numerals that seem to correspond to what the examiner characterizes in the rejection as the disclosure of the Giovanni reference. The noted document in the file does not bear the number (637,711) listed by the examiner on the aforementioned "NOTICE OF REFERENCES CITED" form (attachment to Paper No. 9), does not show the name Giovanni, and does not indicate a date of

Sep., 1966 (9-1966). In the answer (page 6), the examiner points out that a complete copy of this reference was not available. This panel of the board obtained a copy of an Italian patent No. 637,711 in the United States Patent and Trademark Office. However, the document does not bear the name Giovanni, does not show the drawing figures depicted in the reference relied upon by the examiner that is referenced as the Giovanni document, and does not bear a date of 9-1966.

The examiner acknowledges (answer, page 6) that information relied upon in the rejection as evidence of obviousness is predicated upon the "assumption" of what is disclosed in the Giovanni document. It appears that the examiner has not even been able to determine the name of the article (title of the invention) portrayed in the so-called Giovanni reference.

Based upon the examiner's own acknowledgement, and our perception as well, it can only be assumed or speculated upon as to what the content of the Giovanni document, in fact, discloses. This critical deficiency prevents this document, in its current form, from satisfying the requirement that prior art must

sufficiently describe an invention to have placed the public in pos- session of it. See In re Donahue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985).

We share the appellant's point of view (amended brief, page 6) to the effect that the Giovanni document, with its lack of an indication as to even what the subject matter thereof pertains to, is so deficient in its present form that it is not a proper reference, i.e., proper evidence.

Thus, notwithstanding the teaching of Ericson, the rejection of appellant's claims under 35 U.S.C. § 103 must be reversed based upon the stated deficiency of the Giovanni document.

We also remand this application to the examiner to further attempt to ascertain the correct identifying information for the so-called Giovanni document, and to obtain a complete copy thereof (and translation) so that it can be fairly assessed by the examiner relative to any possible use thereof in subsequent prior art rejections of appellant's claims.

The indefiniteness rejection

We reverse this rejection of appellant's claims under 35 U.S.C. § 112, second paragraph.

We certainly appreciate from a reading of appellant's claims 23 and 25 the presence therein, both in the preamble and throughout the body of the claim, reference to the box with which the claimed inflatable cushion is to be used. However, appellant acknowledges in the amended brief (page 11) that the claims clearly state an inflatable cushion, with the references to the use or function of the cushion in packaging items in a box being simply to provide the environment in which the cushion is intended to be used. We likewise understand from our reading of claims 23 and 25 that these claims are broadly drawn to an "inflatable cushion" per se; the recitation throughout the claims of the inflatable cushion being for use in packaging items in a box being but one possible intended use therefor. It is clear that the examiner would likewise view the claims as definite with the aforementioned interpretation thereof (answer, page 7). For the above reasons, we determine that the claims are drawn to an inflatable cushion per se and are definite.

In summary, this panel of the board has:

reversed the rejection of claims 23 through 27 under 35 U.S.C. § 103 as being unpatentable over Giovanni in view of Ericson, and

reversed the rejection of claims 23 through 27 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Additionally, we have remanded the application to the examiner for the purpose stated, supra.

The decision of the examiner is reversed.

This application, by virtue of its “special” status, requires an immediate action, MPEP § 708.01(d).

REVERSED and REMANDED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
NEAL E. ABRAMS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)	

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